

REMARKS

The Court of Appeals for the Federal Circuit has explicitly addressed § 103 and followed the approach the Supreme Court set forth for applying that provision. Section 103 provides, in pertinent part:

A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103(a).

The Supreme Court in *Graham* held that:

While the ultimate questions of patent validity is one of law, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Graham v. John Deere, Co., 383 U.S. 1 (1966).

Thus, under *Graham*, the obviousness inquiry is highly fact specific, and requires an examination of the following: (1) the scope and content of the prior art; (2) the differences between the patented invention and what already existed in the prior art; (3) the ordinary level of skill of people working in the field; and (4) other objective evidence which may suggest that the invention would not have been obvious. The Court also warned lower courts to "guard against slipping into use of hindsight,"...and to resist the temptation to read into the prior art the teachings of the invention in issue." 383 U.S. at 36. See also *Ashland Oil, Co. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 291 (Fed. Cir. 1985), cert. denied 475 U.S. 1017 (1986).

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR International Co. v. Teleflex Inc., 2007 WL 1237837.

Additionally, an invention also may not be rendered obvious unless the prior art is sufficiently enabling. *Motorola, Inc. v. Interdigital Technology Corp.*, 121 F.3d 1461, 1471 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989).

The undated James article discloses, that termites are shown as a "hot" spot. In the presently claimed invention, however, the applicant is looking for cold spots. The reason being is that termites carry a significant amount of water and moisture is shown as a cold spot.

James also differs from the present invention in that he asserts that only infrared data is sufficient to detect termites; however, in the present method, (looking at cold spots) a secondary confirmation is needed to differentiate over other sources of moisture.

The undated James article serves to illustrate just how different and novel the presently claimed invention is as compared to the cited prior art.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance.

Respectfully Submitted,

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